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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,609	03/30/2004	Paul Re	SCAN-1 CON	3229

7590  
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12/27/2006

EXAMINER
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BACHMAN, LINDSEY MICHELE

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,609	<b>Applicant(s)</b> RE ET AL.	
	<b>Examiner</b> Lindsey Bachman	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2,4-7,10,11,13-15,18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,9,12,16,17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9-18-06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Invention I, an encapsulation device for the repair of an articular cartilage defect (Claims 1-17, 20) and further Species A of Invention I, Figures 1, 3-4, 6-8, and 10-12 (Claims 1, 3, 8, 9, 12, 16, 17 and 20) in the reply filed on 10 October 2006 is acknowledged.
2. Claims 2, 4-7, 10-11, 13-15, and 18-19 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10 October 2006.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. **Claims 1, 3, 9, 12, 16, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulhauser, et al. (US Patent 6,267,772) and Noiles (US Patent 4,060,089).**
6. Claims 1 and 3: Mulhauser'772 teaches a tissue repair device containing a body containing a frame portion (14) and a cover portion (12). Further, the device contains legs (22). Mulhauser'772 does not teach that the legs are several times larger than the thickness of the body, nor do the legs contain central channels.
7. Noiles'089 discloses legs (17) for attaching to soft body tissues that contain a central channel (28) and the leg members have pointed end portions. Noiles'089 discloses this configuration because it engages with soft body tissues in a precise manner and retains the tissue to the fastener (column 1, lines 5-23). Noiles'089 teaches protrusions (18a, 19a) for engaging with a retainer strip (13) in order to prevent withdrawal. It would have been obvious to one skilled in the art at the time the invention was made to modify the device taught by Mulhauser'772 with the legs taught by Noiles'089 because they are longer and capable of engaging the tissue better.
8. Claim 9: Mulhauser'772 teaches attaching the cover to the frame using insert molding (column 4, lines 26-34).
9. Claim 12: Mulhauser'772 teaches a shell member (14) and struts (22) that extend from the center of the shell member (center of outer frame circumference).
10. Claim 16: Mulhauser'772 teaches that the fabric can be made of absorbable material (column 4, lines 35-51). Further, Noiles'089 teaches that his device is made of

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bioresorbable material because this is desirable for physiological reasons (column 1, lines 1-23).

11. Claim 17: Mulhauser'772 teaches that the cover can be a material which promotes cell growth (column 4, lines 35-51).

12. Claim 20: Mulhauser'772 teaches a method of repairing a cartilage defect that includes providing a body for disposition against a bone with a defect in which the device contains elongated leg structures (22) for disposition into the bone and bring the distal surface of the device into contact with the bone (column 7, lines 13-35 and column 3, lines 39-41).

**13. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Mulhauser'772 and Noiles'089, as applied to Claim 1, and further in view of Tovey, et al (US Patent 5,370,650).**

14. Mulhauser'772 and Noiles'089 teach the limitations of Claim 8, except for attaching the fabric to the frame with sutures. Tovey'650 teaches the use of sutures to attach the fabric to the frame (column 6, lines 31-45). It would have been obvious to one skilled in the art at the time the invention was made to attach the fabric to the frame by Mulahuser'772 with sutures as taught by Tovey'650 because this allows the fabric to be removably attached.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lindsey Bachman whose telephone number is 571-272-

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6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "M J Hayes", is written above the printed name.

MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER